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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/812,383      | 03/29/2004  | Toshio Ando          | 0275M-659COB        | 2624             |

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EXAMINER

MILLER, WILLIAM L

ART UNIT PAPER NUMBER

3677

DATE MAILED: 01/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                                      |                                    |  |
|------------------------------|--------------------------------------|------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/812,383 | <b>Applicant(s)</b><br>ANDO ET AL. |  |
|                              | <b>Examiner</b><br>William L. Miller | <b>Art Unit</b><br>3677            |  |

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese 11-223207 (hereinafter "JP207") in view of Mizuno et al. (US#6443678), and further in view of Bodin (US#6146076).

3. Regarding claims 1, 5, 9, and 10, and as admitted by the applicant on page 2 of the specification of the instant application, JP207 discloses an elastic fastener 1 comprising: a hollow tubular portion 10; an internally threaded portion 11 provided at a lower end (first end) of the tubular portion; a flange 10a formed at an upper end (second end) of the tubular portion; the tubular portion and flange integrally formed with each other (monolithic) and made of an elastomeric material, namely rubber; and the internally threaded portion being formed of metal and having a nut shape (external surface) wherein it is integrally fixed (fixably coupled) to the tubular portion in a hole (through bore) thereof.

4. Although JP207 fails to disclose the tubular portion being made of the claimed elastomeric materials, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In any event, utilizing a polyamide-based elastomeric material for its inherent strength and tensile elongation properties is known in the fastener art as evidenced by

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Mizuno (col. 2, lines 15-20). Therefore, as taught by Mizuno, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the JP207 fastener by utilizing a tubular portion made of a polyamide-based elastomeric material for its inherent strength and tensile elongation properties.

5. Although JP207 fails to disclose the internally threaded portion being made of the claimed rigid resin materials, the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. In re Leshin, 227 F.2d 197, 125 USPQ 416 (CCPA 1960). In any event, utilizing a nylon-based resin for its inherent material properties is known in the fastener art as evidenced by Bodin (col. 2, lines 52-57). Therefore, as taught by Bodin, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the JP207 fastener by utilizing an internally threaded portion made of a nylon-based resin to improve resiliency and provide a reduction in weight.

6. Regarding claims 2 and 6, although the JP207 as modified fails to specifically disclose the polyamide-based elastomeric material having a JIS-A hardness in the range of 40 to 90 degrees as claimed by the applicant, it would have been an obvious design choice to utilize a polyamide-based elastomeric material having a JIS-A hardness in the range of 40 to 90 degrees since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

7. Regarding claims 3, 4, 7, and 8, although JP207 as modified discloses the flange and tubular portion are integrally formed and the internally threaded portion is formed as a single piece which is joined to the tubular portion, JP207 as modified fails to disclose the method

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limitations of injection molding and fusion bonding as claimed by the applicant. However, the applicant is reminded method limitations are given little patentable weight in an article claim as the patentability of a product does not depend on its method of production. See MPEP 2113.

***Response to Arguments***

8. The applicant argues In re Leshin, 125 USPQ 416, was inappropriately applied to the claims as the substitution of materials in the applicant's invention results in a new and useful result and/or improved efficiency and is therefore non-obvious. However, the rejection of the claims was not a design choice rejection of JP207 in view of In re Leshin, but rather the claims being unpatentable over JP207 in view of the teachings of Mizuno et al. and Bodin. (See paragraph 2 of the previous Office action). The applicant effectively failed to present any arguments regarding the combining of JP207 with the teaching references of Mizuno et al. and Bodin.

9. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it would have been obvious to modify the elastic fastener of JP207 to utilize the claimed materials taught Mizuno et al. and Bodin. Moreover, Mizuno et al. and Bodin each pertain to the fastener art and teach the benefits of the claimed polymer materials, namely a polyamide-based elastomeric material for its inherent strength and tensile elongation properties, and a nylon-based resin for improved resiliency and reduction in weight, respectively.

***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

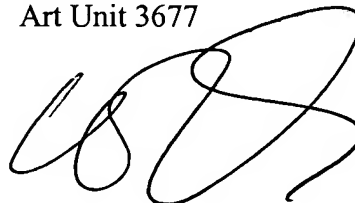
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Miller whose telephone number is 703 305 3978. The examiner can normally be reached on Tuesday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on 703 306 4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L. Miller  
Primary Examiner  
Art Unit 3677

A handwritten signature in black ink, appearing to be 'WLM', written over a horizontal line.

WLM  
01-05-2005